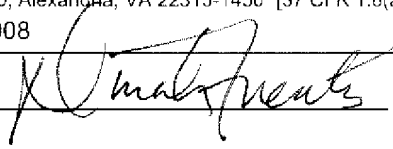



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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		782-A03-009-3	
I hereby certify that this correspondence is being deposited with the United States Patent Office "USPTO" via electronic EFS-WED Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 [37 CFR 1.8(a)] on <u>May 15, 2008</u>		Application Number	Filed
Signature <u></u>		10/685,117	October 14, 2003
Typed or printed name <u>Dinah Fuentes</u>		First Named Inventor	
		Peter M. Bonutti	
		Art Unit	Examiner
		3734	K. Truong
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the			
<input type="checkbox"/> applicant/inventor.		Signature	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		Paul D. Bianco	
<input checked="" type="checkbox"/> attorney or agent of record.		Typed or printed name	
Registration number <u>43,500</u>		305 830-2600	
		Telephone number	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.		May 15, 2008	
Registration number if acting under 37 CFR 1.34 _____		Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s): P. Bonutti

Confirmation No.: 4436

Application No.: 10/685,117

Group Art Unit: 3734

Filed: October 14, 2003

Examiner: K. Truong

For: APPARATUS AND METHOD FOR  
TREATING A FRACTURE OF A BONE

Docket No: 782-A03-009-3

Pre-Appeal Brief Conference

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

To the Pre-Appeal Panel:

The Examiner made clear error when rejecting claims 4, 8-16, 18, 20-24, 26-29, and 31-38 as being anticipated by Bonutti '425 under 35 USC § 102(b) because the reference does teach all of the limitations of the claims for the reasons detailed below. In addition, even if the reference does teach all of the features separately, the features are never taught in the claimed combination to enable one of ordinary skill in the art to practice the invention as is required by 35 USC § 102.

The sole reference in the final office action is Bonutti (US Patent No. 5,593,425). In the final office action, the Examiner emphasizes three separate embodiments: Fig. 2, Fig. 10, and Figs. 11A-11C in Bonutti '425. Applicant notes that Bonutti '425 shares the identical inventor with the instant case.

Claim 4 of the instant application is novel compared to Bonutti '425 because Bonutti '425 does not teach the following claimed features, "A second rigid bone plate positionable ... generally opposite the first bone plate; [and] a suture connected with the first and second rigid bone plates."

The response dated March 9, 2008, page 9, paragraph 3-4, explains why these features are not shown.

The Examiner's response in the April 15, 2008 Office action does not fully respond to the Applicant's argument. The Examiner's answer is listed in Item 11 of the Advisory Action.

In renewing the Section 102(b) rejection, the Examiner combined the embodiment shown in Figs. 10-11C with the embodiment shown in Fig. 2.

MPEP § 2131 states the axiom that, "To anticipate a claim, the reference must teach every element of the claim." This section also cites *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1239 (Fed. Cir. 1989), which states, "The identical invention must be shown in as complete detail as is contained in the ... claim." In addition, "The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). The Federal Circuit in the case of *In re Paulson*, 30 F.3d 1475, 1478-1479, 31 USPQ2d 1671, 1673 (1994) added an additional step in the anticipation analysis: To be anticipating, a prior art reference must disclose "each and every limitation of the claimed invention[,] ... must be enabling[,] and [must] describe... [the] claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention."

The Examiner's rejection violates the guidelines of MPEP § 2131 and the holding in *In re Paulson* by piecing together separate embodiments that have no teaching of how to combine without undue experimentation. Bonutti '425, Fig. 10, shows an embodiment having a suture (180) disposed in a curved opening (178) transversing a joint (176) and having fasteners (180, 182) at opposing ends of the suture (180) abutting the same side of the bone portions (172, 174). Fig. 10 does not show, "A second rigid bone plate ... generally opposite the first bone plate" as is described in claim 4 of the instant application. In contrast to the other embodiment, Bonutti '425, Fig. 2, shows a fastener for attaching a plate (168) to a bone (160), the fastener (162) has two fasteners (170, 164) disposed on opposite sides of the bone (160). Fig. 2 does not teach a suture or a fracture as is described in claim 4 of the instant application. One with ordinary skill in the art reading Bonutti '425 would not be enabled to make the invention as claimed without undue experimentation. Accordingly, Bonutti '425 does not show that one with ordinary skill in the art or the inventor himself (at the time of filing Bonutti '425) possessed the invention according to the claims of the instant application.

Although this combination rejection does raise issues of fact, Applicant believes that the Pre-Appeal Brief Conference is the proper forum because the mistake reaches the level of clear error by the Examiner.

Claim 8 is novel over Bonutti '425 because Bonutti '425 does not teach, "A tubular member positionable in the bone through the fracture." This feature is discussed in the response submitted on March 9, 2008, page 11, paragraphs 2-3. Therefore, claim 8 is patentable over Bonutti '425.

Claim 13 is novel over Bonutti '425 because Bonutti '425 does not teach all of the features of claim 13: "A suture extending through the rigid bone plate...; and at least one fastener positionable through the rigid bone plate into the bone..." These features are discussed in the March 9, 2008, page 11, final paragraph through page 12, first whole paragraph. Because all of the features are not taught, claim 13 is novel.

Claim 23 is novel over Bonutti '425 because Bonutti '425 does not teach, "Moving at least one suture through the passage in the bone and through at least one bone plate." These features are discussed in the March 9, 2008, page 12, second through third full paragraphs. In addition, Applicant repeats its remarks regarding the combination of separate embodiments in one document, which were discussed earlier in this paper. Because Bonutti '425 does not teach all of the features of claim 23 in the same arrangement as claim 23, claim 23 of the instant application is novel.

Claim 32 is novel over Bonutti '425 for the additional reason that the prior art does not teach, "Changing the orientation of at least one anchor from a first to a second configuration thereby causing at least one suture anchor to become proximate to the bone and impassable through at least one passage." Bonutti '425 does not teach such a pivotable anchor. Accordingly claim 32 is not anticipated by Bonutti '425.

For these reasons, the Examiner's rejection in the final Office action dated January 10, 2008, and the Advisory Action dated April 15, 2008, show clear errors in the Examiner's rejections and that the Examiner has omitted essential elements needed for a *prima facie* rejection.

The Applicant notes to the panel that this Request for Pre-Appeal Conference follows a resumption of prosecution following the filing of an amended appeal brief on November 1, 2007. Applicant notes that the prosecution was not furthered by withdrawing the appeal brief. No new references have been cited and a final rejection immediately was issued. In fact, the only reference being cited is the applicant's own prior patent. Accordingly, Applicant requests an allowance of all of the claims; remanding the case only will delay the case further and past experience has shown no art affecting patentability has been found.

If an extension of time for this paper is required, petition for extension is herewith made.

No additional fee is believed due. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 50-0601 (Docket No. 782-A03-009-3).

Respectfully submitted,

/Loren D. Pearson/

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